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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being transmitted via facsimile no. 571-273-8300 to the US Patent and Trademark Office		Application Number	Filed
on <u>August 04, 2005</u>		<u>10/605,568</u>	<u>October 9, 2003</u>
Signature <u>Jessica A. Calaway</u>		First Named Inventor	
Typed or printed name <u>Jessica Calaway</u>		<u>Matus, Tim</u>	
		Art Unit	Examiner
		<u>3742</u>	<u>Yoang, Tu Ba</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>38,368</u> Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p><u>Signature</u> <u>Timothy J. Ziolkowski</u> Typed or printed name</p> <p><u>262-376-5170</u> Telephone number</p> <p><u>August 04, 2005</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Customer No. 33647

Patent
Attorney Docket No. ITW7510.063

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 04 2005

In re Application of : Tim A. Matus et al.
Serial No. : 10/605,568
Filed : October 9, 2003
For : METHOD AND APPARATUS FOR LOCALIZED CONTROL OF A
PLASMA CUTTER
Group Art No. : 3742
Examiner : Tu Ba Yoang

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

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Date: 8/4/05

Jessica A. Calaway
Signature

Commissioner for Patents
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Dear Sir:

A Notice of Appeal is filed concurrently herewith. Applicant requests pre-appeal review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons set forth below.

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REMARKS

Claims 1-22 are pending in the present application. In the Advisory Action mailed July 7, 2005, the Examiner maintained the rejection of claims 1-12, 15-18, and 20-22 under 35 U.S.C. § 102(b) as being anticipated by Schneider et al. (USP 5,866,869). The rejection of claims 14 and 19 under 35 U.S.C. §103 as being unpatentable over Schneider et al was also maintained.

In the first Office Action of 12/08/2004, the Examiner rejected all independent claims of the present application under §102(b), on the belief that:

"Schneider et al. shows all features of the claimed invention, including a plasma cutting system or assembly (Figures 1-2). a plasma cutting power source 102, a plasma torch 100 operationally connected to the plasma cutting power source 102, and a processing unit 104 disposed within the plasma torch as shown in Figure 1 (column 3, lines 11-17) and configured to control the plasma cutting power source (column 4, lines 13-15 and column 5, lines 30-32) of a plasma cutting process (also see column 4, line 66 to column 5, line 6)." OFFICE ACTION 12/08/2004, pg. 2.

However, in Applicant's Response of 03/07/2005, Applicant argued that element 100 of Schneider et al. ("the '869 patent") teaches a plasma cutting system rather than a plasma cutting torch. Specifically, Applicant described how the inclusion of DC power source 102 in what the '869 patent refers to as a "plasma cutting torch 100" would lead one of ordinary skill in the art to interpret reference numeral 100 as representing a plasma cutting system. See RESPONSE 03/07/2005, pgs. 5-6. Additionally, Applicant asserted that the '869 patent teaches only a starting circuit which is not "configured to control the plasma cutting power source during a plasma cutting process," as claimed. *Id.* Therefore, the Examiner should have applied a §103 rejection, at most. The Examiner replied by issuing a Final Office Action on 05/04/2005, reiterating the previous position and alleging that "Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference[s]." FINAL OFFICE ACTION 05/04/2005, pg. 2.

Thereafter, Applicant submitted a Declaration under 37 CFR 1.132 of Joseph Schneider, an inventor of both the present application and the '869 patent, with Applicant's Response of 06/23/2005. In part, the Declaration states that one of ordinary skill in the art would recognize that reference numeral 100 of the '869 patent necessarily refers to the overall plasma cutting system, since a DC power source 102 cannot be located in a torch due to its size and weight and since a plasma torch would be connected to the system at points 'A' and 'E' therein. See DECLARATION 06/23/2005, pgs. 1-2. Additionally, the Declaration states that the '869 patent discloses a starting circuit rather than a circuit capable of controlling a plasma cutting system during a plasma cutting process, as claimed. *Id.*

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The Examiner then issued an Advisory Action on 07/07/2005, in which the Declaration was acknowledged and entered. However, the Examiner stated that "[t]he Declaration set forth can not be used to overcome the rejection and therefore all of the rejections made in the Final rejection are considered proper and thereby are remained." ADVISORY ACTION 07/07/2005, pg. 2. The Examiner noted that since some of the claims have been rejected under §102(b), "there is a time bar." *Id.* As support, the Examiner cited *In re Debaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 687 F.2d 450 215 USPQ 14 (CCPA 1982)). *Id.*

The Examiner seems to have mistakenly regarded the Declaration under Rule 132 as one showing that the '869 patent "is describing Applicant's own work." MPEP §2136.05. Since the exact citation to *In re Debaun* appears in MPEP §2136.05, Applicant believes the Examiner is attempting to apply the rule that an "applicant's own work may not be used against him or her unless there is a time bar under 35 U.S.C. 102(b)." *Id.* While Applicant agrees a Rule 132 Declaration asserting that a reference is Applicant's own work would not be effective in overcoming a valid §102(b) rejection, that is not what the Declaration of 06/23/2005 seeks to achieve. As stated above, the Declaration of 06/23/2005 was submitted to show that the '869 patent does not render the present invention unpatentable because one skilled in the art would not be apprised of how to incorporate a DC power source into a torch handle and thus would interpret the word "torch" as intended to mean "system." See DECLARATION 06/23/2005, pgs. 1-2. In other words, Applicant has asserted via the Declaration that the '869 patent does not enable the teachings relied upon by the Examiner. Therefore, the rule set forth in *In re Debaun* and MPEP §2136.05 is inapplicable.

According to MPEP §§ 2121 and 716.07, a Rule 132 Declaration offered to prove that which Applicant has asserted actually can be used to overcome a §102(b) rejection. That is, a Rule 132 Declaration showing that a §102(b) reference is inoperable as to the cited teachings can be used to overcome a rejection based thereon. Therefore, Applicant believes that the Examiner must consider the Declaration of 07/07/2005 for two reasons. First, the Declaration of 07/07/2005 is appropriate evidence under §§ 2121 and 716.07 since it rebuts the presumption of operability of the '869 patent as to the alleged "teachings" (i.e. whether all shown components can exist inside a plasma torch handle). Additionally, the Declaration is also sufficient to overcome a §102(b) rejection since it satisfies the standard set forth in *In re Yale* for proving that a mistake in a reference does not place the public in possession of the claimed invention. 434 F.2d 66, 168 USPQ 46 (CCPA 1970).

Section 2121 states that "[w]hen the reference relied on expressly anticipates ... all of the elements of the claimed invention ... the burden is on applicant to provide facts rebutting the presumption of operability." The section then explicitly directs the reader to §716.07, entitled "Affidavits or

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Declarations Traversing Rejections, 37 CFR 1.132: Inoperability of References.” Section 716.07 provides for the submission of Rule 132 Declarations to “rebut the presumption of operability” of a reference.

As in the matter of *In re Sasse*, the reference relied on by the Examiner in the present rejection has been cited as expressly anticipating the present invention. See 629 F.2d 675, 207 USPQ 107 (CCPA 1980). As such, “the burden is on applicant to provide facts rebutting the presumption of operability,” which includes the use of a Rule 132 Declaration. MPEP §2121. The Declaration of 07/07/2005 rebuts the presumption that the ‘869 patent is operable for the teachings expressed by the Examiner by explicitly stating that “the DC power supply shown as reference number 102 cannot be located inside of the plasma torch handle because of its size and weight.” DECLARATION 07/07/2005, pg. 2. The disclosure of the ‘869 patent does not enable one of ordinary skill in the art to dispose all the components of a plasma cutting system, such as DC power supply 102 and circuitry 104-108, within the body of a torch. In addition, the Declaration also states that a torch is not shown at all in Figs. 1 and 2 of the ‘869 patent, and that, if shown, a torch “would connect to A and E of the figures.” *Id.* Applicant believes that these statements successfully rebut any presumption that the ‘869 patent enablingly discloses the present invention. According to *In re Sasse*, the Examiner now has the burden of rebutting Applicant’s contention of non-enablement and cannot simply dismiss it. See 629 F.2d at 681, 207 USPQ at 111-12. Unless the Examiner can rebut Applicant’s showing, the disclosure of the ‘869 patent “is inadequate as a statutory bar to patentability under section 102(b).” *Id.* It is noted, however, that Applicant does not question that the claims of the ‘869 patent are enabled, but merely that the Examiner’s interpretation of the reference is enabled.

Applicant also believes the Declaration of 06/23/2005 satisfies the test set forth in *In re Yale*. 434 F.2d at 668-69, 168 USPQ at 48-49. The case of *In re Yale*, as discussed in MPEP §716.07, states that a reference containing an error which happens to literally disclose the claimed invention does not teach the subject matter recited by the error if one of ordinary skill in the art would disregard the alleged teaching as a mistake or immediately substitute the intended phrase in place of the error. *Id.* In *In re Yale*, a chemical formula was inadvertently misidentified in a prior art reference, but the error happened to disclose the invention for which the Applicant therein sought protection. The court held that “[s]ince it is an obvious error, it cannot be said that one of ordinary skill in the art would do anything more than mentally disregard [the error] as a misprint or mentally substitute [the correct formula] in its place.” *Id.* Likewise, Applicant believes that one of ordinary skill in the art would disregard the phrase “plasma cutting torch” in the ‘869 patent and instead mentally substitute “plasma cutting system” in its place. Furthermore, like the situation in *In re Yale*, the Declaration of 06/23/2005 is made by an “author” of the

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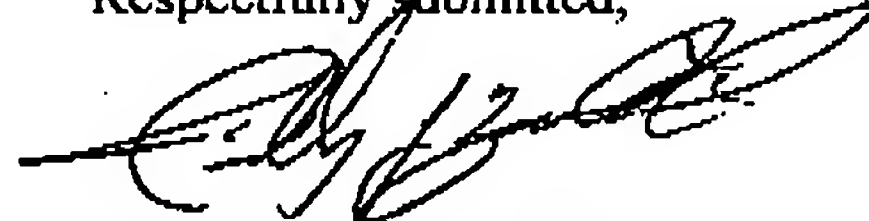
'869 patent and unambiguously states both that the cited language contained therein does not connote what it may literally appears to be and that one of ordinary skill in the art would find any ambiguity to be an obvious mistake. DECLARATION 06/23/2005, pg. 2. Accordingly, Applicant requests that the rejection of claims 1-13, 15-18, and 20-22 be withdrawn.

In regard to the rejection of claims 14 and 19 under §103, the Examiner did not provide any explanation as to why the Declaration of 06/23/2005 has not been considered. See FINAL OFFICE ACTION 06/23/2005, pg. 2. It is well established that a Rule 132 Declaration rebutting a presumption of operability of a reference may be used to overcome a rejection under §103, just as such a declaration may be used to overcome a rejection under §102(b). See MPEP §§ 2121, 716.07. Thus, for the reasons stated above, Applicant requests that the rejection of claims 14 and 19 under §103 also be withdrawn.

As such, Applicant has submitted appropriate and adequate evidence to overcome the rejections under both §102(b) and §103. Therefore, the Examiner must adequately consider the Declaration. MPEP §716.01. Since the Examiner has not done so, a clear error is present. Accordingly, in light of the foregoing, Applicant believes that the present application is in condition for allowance. Applicant therefore requests reversal of the Examiner's rejection and timely issuance of a Notice of Allowance for claims 1-22.

Applicant appreciates the consideration of these Remarks and cordially invites the pre-appeal conference committee to call the undersigned, should it consider any matters unresolved.

Respectfully submitted,



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Dated: 8/4/05
Attorney Docket No.: ITW7510.063

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